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OFFICE OF PETITIONS

In re Application of
Silverbrook et al.
Application No. 10/815,636
Filed: April 2, 2004
Attorney Docket No. HYJ001US

ON PETITION

This is a decision on the renewed petition under 37 CFR § 1.78(a)(3), filed February 24, 2005, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of the prior-filed nonprovisional application set forth in the concurrently filed amendment.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application(s), unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant petition does not comply with item (1) above.

The amendment submitted with the instant petition does not comply with 37 CFR 1.121(b)(1)(ii), which states in part, that an amendment must be made by submitting,

The full text of any replacement paragraph with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strikethrough cannot be easily perceived.

It is not apparent whether petitioner wishes to delete the entire claim for priority or merely the incorporation by reference statement. Petitioner should clearly identify what is being claimed, if anything, and what is being deleted in accordance with 37 CFR 1.121.

Further, the renewed petition and any amendments submitted must be signed by all of the inventors.

Accordingly, before the petition under 37 CFR 1.78(a)(3) can be granted, a substitute amendment¹, along with a renewed petition under 37 CFR 1.78(a)(3), and signed by all of the inventors, is required.

Further correspondence with respect to this matter should be addressed as follows:


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Any questions concerning this matter may be directed to Paralegal Liana Chase at (571) 272-3206.


Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

¹ Note 37 CFR 1.121